REMARKS

1. Present Status of Patent Application

This is a full and timely response to the outstanding non-final Office Action mailed April 7, 2005. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

2. Examiner Interview

Applicant first wishes to express his sincere appreciation for the time that Examiner Chang spent with Applicant's Attorney, Charles Griggers, during a telephone discussion on May 24, 2005 regarding the outstanding Office Action. During that conversation, the pending claims were discussed. In particular, Applicant's attorney suggested potential avenues in further distinguishing the claims from the cited art in order to advance prosecution, and the Examiner reserved judgment with regard to these suggestions and their potential effect in advancing prosecution. Thus, no consensus was reached at the end of the telephone discussion. Applicant respectfully requests that the Examiner carefully consider this response and the amendments contained herein.

3. Response to Objections of Claims 50 and 51

Claims 50 and 51 stand objected to as being in improper form because claims 50 and 51 duplicate claims 47 and 52 respectively. In response, claims 47 and 52 have been amended to overcome the objections. Therefore, the objections should be withdrawn.

4. Response to Rejection of Claims 1-9, 14-25, 31-36, 40-45, and 47-52 Under
35 U.S.C. § 103(a)

In the Office Action, claims 1-9, 14-25, 31-36, 40-45, and 47-52 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Sumner* (U.S. Patent Application No. 2002/0061003) in view of *Skladman* (U.S. Patent No. 6,400,810). For a proper rejection of a claim under 35 U.S.C. § 103, the teachings of the cited art reference must suggest all the features of the claimed subject matter to one of ordinary skill in the art. *See, e.g., In re Dow Chemical*, 837 F.2d

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469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981).

a. Claim 1

As provided in independent claim 1, Applicant claims:

An apparatus for notifying a subscriber of new email messages located at a post office, comprising:

a wireless proxy email client in communication with a wireless network and a post office via an external network, the wireless proxy email client utilizing information from a file containing the subscriber's information to access the subscriber's email account at the post office at the external network, the wireless proxy email client retrieving a portion of an email message from the subscriber's account to uniquely identify the email message and sending a notification to the subscriber for alerting the subscriber of the email message at the post office.

(Emphasis added).

Applicant respectfully submits that independent claim 1 is allowable for at least the reason that *Sumner* in view of *Skladman* does not disclose, teach, or suggest at least the feature of "a wireless proxy email client in communication with a wireless network and a post office via an external network, the wireless proxy email client utilizing information from a file containing the subscriber's information to access the subscriber's email account at the post office at the external network, the wireless proxy email client retrieving a portion of an email message from the subscriber's account to uniquely identify the email message and sending a notification to the subscriber for alerting the subscriber of the email message at the post office," as recited in claim 1.

For example, *Sumner* discloses a system with a wireless messaging engine 320 which "functions as a messaging server for wireless messaging system subscribers. . . . The wireless messaging engine 320 receives the message from the Internet 215 . . . [and] determines the proper routing to the wireless subscriber unit 340." As such, *Sumner* fails to disclose at least the features of a wireless proxy email client, retrieving a portion of an email message from the subscriber's account to uniquely identify the email message, and sending a notification to the subscriber for alerting the subscriber of the email message at the post office. In contrast, *Sumner*

discloses a messaging gateway and a process for retrieving messages in their entirety and delivering them to a subscriber.

Further, *Skladman* is legally inadequate to cure the deficiencies of the *Sumner* reference. For example, *Skladman* teaches that a "notification server 26 can be configured to poll the e-mail server 18 at predetermined intervals to check for new e-mail." Col. 3, lines 40-42. Further, "[e]-mail notices originate at the email server 18 and can be passed to the notification server 26." Col. 3, lines 38-40. "Upon receiving the e-mail notice, the notification server 26 compares the e-mail notice to the e-mail attributes in the filter list 16 (step 66). Based on the comparison between the e-mail notice and the filter list 16, the notification server 26 can either transfer the e-mail notice to the interface 28 or block its transfer (step 68)." Col. 5, lines 20-25. As such, *Sladman* fails to also disclose, teach, or suggest at least the features of a wireless proxy email client, retrieving a portion of an email message (via the wireless proxy email client) from the subscriber's account to uniquely identify the email message, and sending a notification to the subscriber (via the wireless proxy email client) for alerting the subscriber of the email message at the post office, as featured in claim 1. In contrast, *Skladman* discloses a process for generating e-mail notices utilizing a notification server and/or e-mail server.

Therefore, the proposed combination of *Sumner* in view of *Skladman* does not disclose, teach, or suggest all of the features of claim 1, for at least these reasons.

b. Claims 2, 4-9, and 14-17

If independent claim 1 is allowable over the cited art of record, then its dependent claims 2, 4-9, and 14-17 are allowable as a matter of law, because these dependent claims contain all the features and elements of their respective independent claim 1. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Additionally and notwithstanding the foregoing reasons for the allowability of claims 2, 4-9, and 14-17, these dependent claims recite further features/elements and/or combinations of features/elements (as is apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Hence, there are other reasons why these dependent claims are allowable.

c. <u>Claim 18</u>

As provided in independent claim 18, Applicant claims:

> A system for notifying a subscriber of new email messages located at a post office, comprising:
>
> *a wireless proxy email client in communication with a wireless network and a post office via an external network, the wireless proxy email client utilizing information from a file containing the subscriber's information to access the subscriber's email account at the post office, the wireless proxy email client retrieving a portion of a new email message to determine whether the subscriber has been notified of the new email message previously and sending a notification to the subscriber for alerting the subscriber of the new email message at the post office if the subscriber has not been notified previously about the new email message.*

(Emphasis added).

Applicant respectfully submits that independent claim 18 is allowable for at least the reason that *Sumner* in view of *Skladman* does not disclose, teach, or suggest at least the feature of "a wireless proxy email client in communication with a wireless network and a post office via an external network, the wireless proxy email client utilizing information from a file containing the subscriber's information to access the subscriber's email account at the post office, the wireless proxy email client retrieving a portion of a new email message to determine whether the subscriber has been notified of the new email message previously and sending a notification to the subscriber for alerting the subscriber of the new email message at the post office if the subscriber has not been notified previously about the new email message," as recited in claim 18.

For example, *Sumner* discloses a system with a wireless messaging engine 320 which "functions as a messaging server for wireless messaging system subscribers. . . . The wireless messaging engine 320 receives the message from the Internet 215 . . . [and] determines the proper routing to the wireless subscriber unit 340." As such, *Sumner* fails to disclose at least the features of a wireless proxy email client, retrieving a portion of a new email message from the subscriber's account to determine whether the subscriber has been notified of the new email message previously, and sending a notification to the subscriber for alerting the subscriber of the new email message at the post office if the subscriber has not been notified previously about the

new email message. In contrast, *Sumner* discloses a messaging gateway and a process for retrieving messages in their entirety and delivering them to a subscriber.

Further, *Skladman* is legally inadequate to cure the deficiencies of the *Sumner* reference. For example, *Skladman* teaches that a "notification server 26 can be configured to poll the e-mail server 18 at predetermined intervals to check for new e-mail." Col. 3, lines 40-42. Further, "[e]-mail notices originate at the email server 18 and can be passed to the notification server 26." Col. 3, lines 38-40. "Upon receiving the e-mail notice, the notification server 26 compares the e-mail notice to the e-mail attributes in the filter list 16 (step 66). Based on the comparison between the e-mail notice and the filter list 16, the notification server 26 can either transfer the e-mail notice to the interface 28 or block its transfer (step 68)." Col. 5, lines 20-25. As such, *Sladman* fails to also disclose, teach, or suggest at least the features of a wireless proxy email client, retrieving a portion of an email message (via the wireless proxy email client) from the subscriber's account to determine whether the subscriber has been notified of the new email message previously, and sending a notification to the subscriber (via the wireless proxy email client) for alerting the subscriber of the email message at the post office if the subscriber has not been notified previously about the new email message, as featured in claim 18. In contrast, *Skladman* discloses a process for generating e-mail notices utilizing a notification server and/or e-mail server.

Therefore, the proposed combination of *Sumner* in view of *Skladman* does not disclose, teach, or suggest all of the features of claim 18, for at least these reasons.

d. Claims 19-25 and 31-34

If independent claim 18 is allowable over the cited art of record, then its dependent claims 19-25 and 31-34 are allowable as a matter of law, because these dependent claims contain all the features and elements of their respective independent claim 18. Additionally and notwithstanding the foregoing reasons for the allowability of claims 19-25 and 31-34, these dependent claims recite further features/elements and/or combinations of features/elements (as is apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Hence, there are other reasons why these dependent claims are allowable.

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e. Claim 35

As provided in independent claim 18, Applicant claims:

> A method for notifying a subscriber of new email messages located at a post office, comprising:
> establishing communication with a wireless proxy email client via an external network;
> utilizing a subscriber's information contained in a file to access the subscriber's email account at the post office;
> *retrieving a portion of an email message by the wireless proxy email client from the post office to uniquely identify the email message;*
> *determining whether the subscriber has been previously notified about the email message; and*
> *sending a notification to the subscriber for alerting the subscriber of the new email message at the post office about which the subscriber has not been previously notified.*

(Emphasis added).

Applicant respectfully submits that independent claim 35 is allowable for at least the reason that *Sumner* in view of *Skladman* does not disclose, teach, or suggest at least the features of "retrieving a portion of an email message by the wireless proxy email client from the post office to uniquely identify the email message; determining whether the subscriber has been previously notified about the email message; and sending a notification to the subscriber for alerting the subscriber of the new email message at the post office about which the subscriber has not been previously notified" as recited in claim 35.

For example, *Sumner* discloses a system with a wireless messaging engine 320 which "functions as a messaging server for wireless messaging system subscribers. . . . The wireless messaging engine 320 receives the message from the Internet 215 . . . [and] determines the proper routing to the wireless subscriber unit 340." As such, *Sumner* fails to disclose at least the claimed features of a wireless proxy email client, retrieving a portion of an email message by the wireless proxy email client from the post office to uniquely identify the email message; determining whether the subscriber has been previously notified about the email message; and sending a notification to the subscriber for alerting the subscriber of the new email message at the post office about which the subscriber has not been previously notified. In contrast, *Sumner*

discloses a messaging gateway and a process for retrieving messages in their entirety and delivering them to a subscriber.

Further, *Skladman* is legally inadequate to cure the deficiencies of the *Sumner* reference. For example, *Skladman* teaches that a "notification server 26 can be configured to poll the e-mail server 18 at predetermined intervals to check for new e-mail." Col. 3, lines 40-42. Further, "[e]-mail notices originate at the email server 18 and can be passed to the notification server 26." Col. 3, lines 38-40. "Upon receiving the e-mail notice, the notification server 26 compares the e-mail notice to the e-mail attributes in the filter list 16 (step 66). Based on the comparison between the e-mail notice and the filter list 16, the notification server 26 can either transfer the e-mail notice to the interface 28 or block its transfer (step 68)." Col. 5, lines 20-25. As such, *Sladman* fails to also disclose, teach, or suggest at least the features of a wireless proxy email client, retrieving a portion of an email message by the wireless proxy email client from the post office to uniquely identify the email message, determining whether the subscriber has been previously notified about the email message; and sending a notification to the subscriber for alerting the subscriber of the new email message at the post office about which the subscriber has not been previously notified, as featured in claim 35. In contrast, *Skladman* discloses a process for generating e-mail notices utilizing a notification server and/or e-mail server.

Therefore, the proposed combination of *Sumner* in view of *Skladman* does not disclose, teach, or suggest all of the features of claim 35, for at least these reasons.

f. Claims 36, 40-45, and 47-52

If independent claim 35 is allowable over the cited art of record, then its dependent claims 36, 40-45, and 47-52 are allowable as a matter of law, because these dependent claims contain all the features and steps of their respective independent claim 35. Additionally and notwithstanding the foregoing reasons for the allowability of claims 36, 40-45, and 47-52, these dependent claims recite further features/steps and/or combinations of features/steps (as is apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Hence, there are other reasons why these dependent claims are allowable.

5. Response to Rejection of Claims 10-11 and 26-28 Under 35 U.S.C. § 103(a)

In the Office Action, claims 10-11 and 26-28 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Sumner* in view of *Skladman* in further view of Official Notice. For a proper rejection of a claim under 35 U.S.C. § 103, the teachings of the cited art reference must suggest all the features of the claimed subject matter to one of ordinary skill in the art. *See, e.g., In re Dow Chemical*, 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981).

If respective independent claims 1 and 18 are allowable over the cited art of record, then their dependent claims 10-11 and 26-28 are allowable as a matter of law, because these dependent claims contain all the features and elements of their respective independent claims. Additionally and notwithstanding the foregoing reasons for the allowability of claims 10-11 and 26-28, these dependent claims recite further features/elements and/or combinations of features/elements (as is apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Hence, there are other reasons why these dependent claims are allowable.

6. Response to Rejection of Claims 12-13, 29-30, 37-39, and 46 Under 35 U.S.C. § 103(a)

In the Office Action, claims 12-13, 29-30, 37-39, and 46 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Sumner* in view of *Skladman* and *Ng* (U.S. Patent No. 6,640,301). For a proper rejection of a claim under 35 U.S.C. § 103, the teachings of the cited art reference must suggest all the features of the claimed subject matter to one of ordinary skill in the art. *See, e.g., In re Dow Chemical*, 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981).

If respective independent claims 1, 18, and 35 are allowable over the cited art of record, then their dependent claims 12-13, 29-30, 37-39, and 46 are allowable as a matter of law, because these dependent claims contain all the features, elements, and/or steps of their respective independent claims. Additionally and notwithstanding the foregoing reasons for the allowability of claims 12-13, 29-30, 37-39, and 46, these dependent claims recite further features/elements/steps and/or combinations of features/elements/steps (as is apparent by examination of the claims

themselves) that are patentably distinct from the cited art of record. Hence, there are other reasons why these dependent claims are allowable.

7.   Miscellaneous Findings

a. Inherency

Applicant respectfully traverses the finding in the Office Action, with regard to claims 2 and 4, that a subscriber profile with "profile information [] inherently contains login information, passwords, servers information associated with the login data; page 3, [0038]; login information; page 4, [0040]." (Office Action, p. 4, item no. 8). This list of features is not necessarily present as part of profile information within a subscriber's profile. For example, a subset of this information may not be maintained in a subscriber profile if an application (being utilized by the subscriber) is pre-configured with certain information.

Applicant also respectfully traverses the finding in the Office Action, with regard to claim 14, that an "email [] inherently comprises a header portion, i.e., "To header", "From header", and a body portion." (Office Action, p. 5, item no. 14). This list of features is not necessarily present as part of an email message. For example, information normally carried in a header may be contained in a body portion of an email message.

Thus, in accordance with *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2D (BNA) 1949, 1950-51 (Fed. Cir. 1999), Applicant traverses these finding as being inadequate to show why the claimed features are "necessarily present" in the references. Consequently, because of the lack of extrinsic evidence required under *In re Robertson*, the Office Action's statements are merely conclusory and not adequately supported, and the rejections for claims 2, 4, and 14 should be withdrawn. If the rejections of claims 2, 4, and 14 are maintained, Applicants respectfully request that an explanation be provided as to why the claimed features would be necessary in an email message.

b. Official Notice

Applicant respectfully traverses the finding in the Office Action, with regard to claims 10, 11, and 26-28 of Official Notice. First, Applicant is unable to ascertain what facts of which the

Office Action is taking "official notice." Therefore, Applicant respectfully requests additional explanation to be provided in the next office action, if the "official notice" is to be maintained.
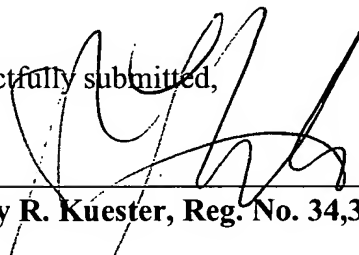
Further, per MPEP 2144.03(A), "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." Also, per MPEP 2144.03(B), "If such notice is taken, the basis for such reasoning must be set forth explicitly. The Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge." As specific factual findings predicated on sound technical and scientific reasoning in support of the conclusion of common knowledge are not provided in the Office Action, the Official Notice should be withdrawn.

CONCLUSION

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims are in condition for allowance. In addition, Applicant does not intend to admit anything regarding any other statements in the Office Action that is not explicitly referenced in this response. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,

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